

**Remarks/Arguments**

**The Rejection of Claims 1 and 23 Under 35 U.S.C. 112, Second Paragraph**

The Examiner rejected Claims 1 and 23 under 35 U.S.C. 112, second paragraph regarding the recitation of “that is to say” in Claim 1 and the recitation of an idle controller function in Claim 23. Applicants have amended the claims to correct the issues noted by the Examiner.

Applicants courteously request that the rejection be removed.

**The Rejection of Claims 1-5 and 21-23 Under 35 U.S.C. 103(a)**

The Examiner rejected Claims 1-5 and 21-23 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,052,246 (Yamaguchi ‘246) in view of U.S. Patent No. 5,216,938 (Yamaguchi ‘938).

**Claim 1**

**Yamaguchi ‘246 does not teach the impairments recited in Claim 1**

Amended Claim 1 recites: “determining, using the electronic engine control unit (132) and the signals received or transmitted by the electronic engine control unit (132), whether there is a functional impairment in the torque transmission device (114, 116), the actuation device (106), or the electronic transmission control unit (110);”

The Examiner cited col. 4, line 1-68 of Yamaguchi ‘246 as teaching the above claim limitation. However, Yamaguchi ‘246 only teaches determination of a problem in a communication line, for example, in col. 4, lines 1-4; and 44-47, is silent regarding the above claim limitation.

**Yamaguchi ‘938 does not teach the impairments recited in Claim 1**

Yamaguchi ‘938 is silent regarding detecting a problem with a torque transmission device or a transmission control unit. Assuming *arguendo* that change gear mechanism 11 in Yamaguchi ‘938 is analogous to actuation device (106) in Claim 1, that is, both devices do the actual gear changing, Yamaguchi ‘938 does not teach a connection between computer 14 and mechanism 11. Instead, Yamaguchi ‘938 teaches that computer 14 has a signal connection to

solenoids 15a, 15b, and 16, which are connected to valve 15, which is connected to mechanism 11. Thus, assuming *arguendo* that computer 14 is able to determine any problems with components to which it is connected, at most, computer 14 would only be able to determine a problem with solenoids 15a, 15b, or 16, and would have no way of determining a problem with mechanism 11 to which it is not connected.

Yamaguchi '938 does not respond to the impairments recited in Claim 1

Amended Claim 1 recites: "and limiting, using the electronic engine control unit (132), the maximum permissible engine torque of the combustion engine when the electronic engine control unit (132) has determined a functional impairment."

The Examiner cited Yamaguchi '938 as teaching the above claim limitation. However, Applicants have shown that neither Yamaguchi '246 nor Yamaguchi '938 teach the impairment recited in Claim 1; therefore, Yamaguchi '246 cannot teach responding to the impairments recited in Claim 1. Instead, Yamaguchi is solely directed to manipulating engine torque in response to a sensor failure, a solenoid failure, or a communication line failure, none of which are included in the above claim limitation.

The sensors taught by Yamaguchi '938 are not part of a torque transmission device, a transmission, or a transmission control unit. As would be well known in the art and as shown and described by Yamaguchi '938, for example, in Figure 1, the air intake, throttle, and speed sensors of Yamaguchi 938 are separate and independent components in communication with a controller, but are not part of the controller. Nor are these sensors part of a torque transmission device or a transmission.

Applicants have shown *supra* that solenoids 16, 15a, and 15b are not analogous to actuation device (106).

The Examiner cited the following excerpts from Yamaguchi '938. None of the excerpts teach the functional impairments recited in Claim 1:

Abstract: Directed to a fail-safe faculty in response to a sensor failure or a communication line failure, for example, 14<sup>th</sup> – 19<sup>th</sup> lines.

Columns 7-8, lines 35-42: Teach components of Figure 1.

Columns 9-11, lines 65-18: Failure of a shift solenoid and a line pressure solenoid (col. 9, lines 2-4 and 27-29; failure of a communication line (col. 9, lines 33 and 34); failure of a speed sensor (col. 9, lines 42 and 43); sensor failure (col. 11, lines 8-10); and operation of sensors (col. 11, lines 14-18).

Columns 12-13, lines 54-47: Communication line (col. 12, lines 57-59); sensors (col. 12, line 65); communication line and sensors (col. 12, lines 20-25).

Columns 14-15, lines 46-39: Speed sensors, switches, and communication line (col. 14, lines 46-59); sensors (col. 14, lines 60 and 61); sensors (col. 15, lines 9-28).

Columns 16-17, lines 6-52: Communication line (col. 16, lines 6 and 7); shift solenoids (col. 16, lines 52 and 54); col. 17 is directed to embodiments that are described as being substantially similar to previous embodiments (addressed above).

For all the reasons noted above, Yamaguchi '246 and '938 fail to teach, suggest, or motivate every element of Claim 1; therefore, Claim 1 is patentable over the cited references. Claims 21-23, dependent from Claim 1, also are patentable over the cited references.

### **Claim 2**

Amended Claim 2 recites: "determining whether the electronic transmission control unit (110), the actuation device (106), or the torque transmission device (114) is functionally impaired."

The arguments regarding Claim 1 are applicable to Claim 2; therefore, Claim 2 is patentable over the cited references. Claim 4, dependent from Claim 1, also is patentable over the cited references.

### **Claim 3**

Claim 3 recites: "turning off the combustion engine (124)...."

The Examiner cited the following excerpts from Yamaguchi '246 as teaching the above claim limitation. None of the excerpts teach turning off an engine, for example, in response to the conditions recited in Claim 3:

Col. 5-6, lines 21-28: Describes the components in Figure 1.

Col. 6-7, lines 30-45: Directed to a gear shift operation, for example, controlling line pressure via solenoid 16.

For all the reasons noted above, Yamaguchi '246 and '938 fail to teach, suggest, or motivate every element of Claim 3; therefore, Claim 3 is patentable over the cited references. Claim 5, dependent from Claim 3, also is patentable over the cited references.

**Conclusion**

Applicant respectfully submits that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

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